REMARKS/ARGUMENTS

Entry of the current amendment and allowance as currently amended is respectfully requested. Independent claims 1 and 17 have been amended to further clarify the invention. New claims 24-27, including new independent claim 24 have been added to further claim the invention.

Claims 1 and 17 are amended to clarify that applicant's invention transfers multiple records of individuals from an existing database to the web-based database and does not generally seek to process individual customer data records. Claim 17 is also amended to clarify that the invention functions with multiple customer data records and further generates multiple access accounts. In addition, claim 17 is amended to clarify that applicant's system enables modification of the customer data records.

New claims 24-27 are presented to further claim the invention. Independent claim 24 is directed towards a method for customers to update their contact information without registering with the system. Claim 25 is directed toward specific types of customer information. Claim 26 is directed towards modification of the customer record via a telephone number. Claim 27 is directed towards the modification being a correction.

The attached amendment does not add new matter and is for clarification of the registration process only. Support for the amendments can be found, inter alia, at paragraphs 24, 27, and 38.

The rejections in the July 12, 2005 Office Action ("OA") were all obviousness-related based on U.S. Patent 6,684,248 to Janacek et al. ("Janacek") in view of U.S. Patent 6,269,369 to Robertson ("Robertson"). Additionally, Janacek and Robertson in further view of U.S. Patent 6,427,164 to Reilly ("Reilly"), U.S. Patent 5,961,620 to Trent et al. ("Trent"), U.S. Patent 6,434,379 to Despres et al. ("Despres") and U.S. Patent 6,108,691 to Lee et al. ("Lee") were relied upon to reject specific additional limitations found in the dependent claims.

U.S. Patent 6,684,248 to Janacek is an improper reference

Examiner relies upon Janacek as the primary reference for all obviousness rejections, but fails to consider whether Janacek is proper prior art.
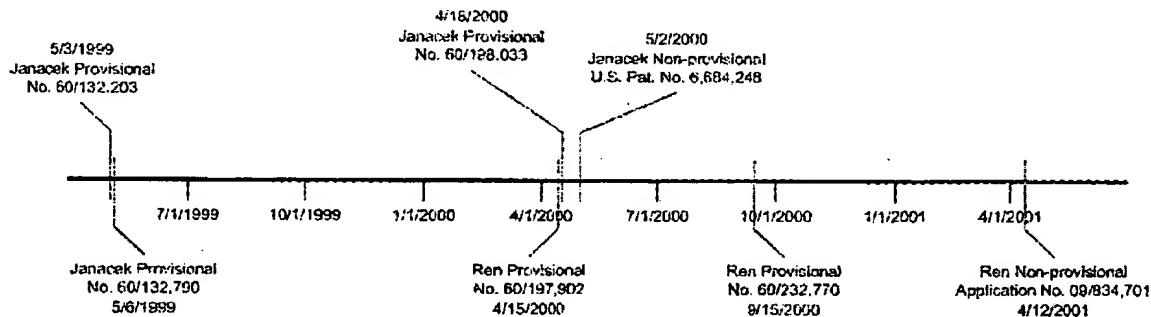
The Janacek non-provisional application was filed on May 2, 2000 claiming priority from three U.S. Provisional applications: Provisional application No. 60/132/203 filed May 3, 1999 ("the '203 Provisional"), Provisional application No. 60/132,790 filed May 6, 1999 ("the '790 Provisional"), and Provisional application No. 60/198,033 filed April 18, 2000 ("the '033 Provisional").

The current non-provisional application was filed on April 12, 2001 claiming priority to two U.S. Provisional applications: Provisional application No. 60/197,902

filed April 15, 2000 and Provisional application No. 60/232,770 filed September 15, 2000.

The above filing dates are represented more clearly by the timeline below:

Janacek filed two provisional applications prior to filing the detailed provisional upon which this application was based. Only material present in those two earlier provisionals **and** the resulting patent is considered prior art under 35 U.S.C. 102(e). See MPEP §§ 2136.02-03. It is therefore improper to base any 103(a) rejections on Janacek's issued patent alone. The provisional applications filed before the current application's claimed priority date of April 15, 2000 must be reviewed and a determination made as to whether the Janacek '203 or '790 Provisional applications provide support and enablement for the disclosed matter which the 103(a) rejections are based.

Applicant has reviewed the Janacek '203 and '790 Provisional applications and respectfully submits that these provisional applications are insufficient to support or enable the matter relied upon by examiner in rejecting applicant's claims. These

two provisional applications are nothing more than high-level sales presentations with a very basic summary document.

Furthermore, the CCPA has held that "if a patent could not theoretically have issued the day the application was filed, it is not entitled to be used against another as 'secret prior art'" under 35 U.S.C. 102(e). *In re Wertheim*, 646 F.2d 527,537 (C.C.P.A. 1981); *see also* MPEP § 2136.03(IV). Because Janacek's two May 1999 provisional applications contained no claims and very little disclosure, it is improper to use Janacek as "secret prior art" now.

Because the Janacek '790 and '203 Provisional applications are insufficient to support the matter relied upon by examiner, the Janacek '248 Patent is entitled to a 35 U.S.C. 102(e) prior art date no earlier than April 18, 2000. Applicant's claimed priority date is April 15, 2000 and thus Janacek '248 is not available as prior art for the 103(a) rejections relied upon by examiner.

35 U.S.C. § 103(a) Rejections

Assuming, arguendo, Janacek '248 is not an improper prior art reference, Applicant will further address the 35 U.S.C. § 103(a) rejections presented in the Office Action by way of the current amendment.

Regarding Claim 1, Applicant clarified that the invention is directed at "transferring multiple ~~receiving~~ records of individuals from an existing database to the web-based database automatically and without express registration action in the

web-based database—by the individuals" to emphasize the difference between applicant's invention and Janacek. Janacek discloses a system for sending email messages with a confirmed delivery "where a recipient of the message need not be a party to the network or maintain an active address in the network." See Abstract and col. 5, line 43 to col. 6, line 12. Janacek further discloses that "new accounts are created dynamically." *Id.* Janacek's system for sending emails to non-members creates accounts "dynamically", **but not automatically**. In Janacek, the "account initialization" process is not started until there is an unprocessed certified message. Col. 6, lines 15-19. The unprocessed certified message can only be created by a member typing an email including an email address and pressing the send button. Once all of these manual steps have been taken, the account is dynamically created by the software. This dynamic account creation process is far removed from applicant's automatic account creation process requiring no user intervention. Dynamic creation after a user takes some form of action is not similar to automatic creation without any user action.

Additionally, Janacek does not disclose "from an existing database" as claimed by applicant. In Janacek, the process that begins the dynamic account creation for non-members is started by a person manually typing in an email. Col. 5, lines 51-59. Upon the user hitting the "send" button, the dynamic account creation process begins. The non-member information comes from human

interaction and not from an existing database. While the non-member's email address could originate in an existing "address book", this would only involve the non-member's email address. The actual information sent to the non-member consists of an email message and attachments, not the non-member's email address. As such, Janacek fails to disclose or suggest Applicant's claimed "transferring records of multiple individuals from an existing database."

In contrast to Janacek's disclosure, Applicant's invention automatically creates multiple user accounts via a fully automatic process that does not require user intervention for each account creation. Applicant transfers "records of multiple individuals <u>from an existing database automatically</u>" and populates "a web-based database with the records of the multiple individuals <u>from the existing database</u>." The only user interaction may be the initial transfer of an "existing database" into the web-based database. Once the transfer process is completed, no additional human interaction is required for Applicant's invention. Janacek's email system implicitly requires a user to type in each individual email (record) from memory. Janacek's system teaches away from the use of an "existing database" making Applicant's invention non-obvious over any combination of references based on Janacek.

The above arguments regarding claim 1 are equally applicable to independent claims 17 and 24. As such, all independent claims and thus all

Response to July 12, 2005 Office Action
U.S. Ser. No. 10/249,205
Page 14 of 15

denendent claims should be in condition for allowance. As such Annlicant